

## REMARKS

### REQUEST FOR RECONSIDERATION

In the Advisory Action dated July 18, 2005, the Examiner stated that the Request for Reconsideration had been considered but did not place the Application in condition for allowance because the product claims contained method limitations and these method limitations failed to further define the copolymer of the present Invention from the copolymer of the prior art.

Applicants have carefully considered this issue raised by the Examiner but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the following remarks.

### REJECTION

In the Office Action dated May 3, 2005, all of the claims had been rejected as being anticipated by or obvious over Sampei or a combination of Sampei and Arimoto. It had been the Examiner's position that Sampei teaches the dry photothermographic imaging material of the claims.

In the Response to the May 3, 2005 Office Action, Applicants had amended the claims to recite that the copolymer used in the polymer layer was produced by a pearl polymerization method. Applicants went on to explain in their Remarks, how pearl polymerization is different from other polymerization methods and that the prior art did not teach pearl polymerization.

In fact, Sampei is silent on any specific manner within which to form its polymer and Arimoto teaches a number of different polymerization methods but prefers emulsion polymerization.

In order to distinguish the present Invention from the teachings of the prior art, Claim 1 had been amended to recite that the copolymer is made by a pearl polymerization. Applicants respectfully traverse this rejection.

First, it should be noted that process limitations, when they appear in product claims, are acceptable and must be considered by the Examiner, see M.P.E.P. 2113 wherein it states that "...product-by-process claims are limited by and

defined by the process...". Thus, the process limitation, which has been recited in Claim 1, is a limitation which must be considered by the Examiner.

The question is "how does the product, which is produced by the process limitation as recited in the claim, differ from the product of the prior art?"

As brought out in the previous Response on pages 7 and 8, there are a number of processes that can be employed to make the copolymer. Each of these processes results in differences in the product.

Thus, it is submitted that the process limitation, which is recited in Claim 1 does, in fact, differentiate the product, as recited in Claim 1, from the product recited in Sampei. This is especially true because Sampei teaches no process for preparing its material. Because Sampei recites no process, the claimed Invention defines over Sampei because it specifies a very specific process which results in a different product than other processes which are used to make copolymers.

The basic rule still remains, however, as to whether the product itself is novel and unobvious in light of the products of the prior art. Therefore, it is submitted that the structure employed by the process steps should be considered when assessing the patentability of the product-by-process claim over the prior art. Applicants have submitted the claim which limits the specific way in which the copolymer is made and such process limitations put limitations upon the product which define over the product of the prior art.

#### CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are

hereby made and authorization is given to debit Account #  
02-2275.

Respectfully submitted,

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